



18 SEP 2006

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In re Application of  
Young-Min SONG  
Application No.: 10/527,013  
PCT No.: PCT/KR04/01397  
Int. Filing Date: 11 June 2004  
Priority Date: 22 April 2004  
Attorney Docket No.: RODA 101  
For: AUXILIARY TOOL FOR EXAMINATION  
OF BIOPSY SPECIMEN

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: DECISION ON  
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This is a decision on applicants' "Petition under 37 CFR 1.497(d)", filed on 07 June 2006 in the United States Patent and Trademark Office (USPTO), to add Kyeongil Kim as a co-inventor in the above reference application.

**BACKGROUND**

On 07 March 2005, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, inter alia, the basic national fee. The first page of the transmittal letter incorrectly indicated an international application no. PCT/RK04/01397; it should have read PCT/KR04/01397 as listed on the subsequent pages.

On 27 December 2005, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration, in compliance with 37 CFR 1.497(a) and (b), was required because the declaration submitted on 07 March 2005 identified an inventor not listed on the international application.

On 16 February 2006, applicant filed "Corrected Application Papers Transmittal" indicating that Mr. Lee is listed on the Request as a co-inventor. Applicant did not provide Form PCT/IB/306 adding Sei-Jin Lee as a co-inventor.

On 21 April 2006, a decision was mailed to applicant indicating that the declaration was unacceptable and not in compliance with 37 CFR 1.497(a) and (b). The published international application PCT/KR04/01397 reveals that Young-Min Song is the sole inventor. The declaration submitted on 07 March 2005 identified Kyeongil Kim as a co-inventor with Young-Min Song. Since there is no indication that Kyeongil Kim was accepted by the International Bureau under PCT Rule 92bis as a co-inventor, it is improper to accept the declaration identifying him as a co-inventor. On 7 June 2006, applicant filed the instant petition under 37 CFR 1.497(d) to add Kyeongil Kim as an inventor.

### DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d)<sup>1</sup> names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added or deleted as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(I); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).

The processing fee of \$130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), there is no indication that an Assignment of Patent Application by the inventors has occurred. If an assignment was executed by any of the original named inventors, a written consent of the assignee(s) would be required. Thus, Item (3) above is not applicable.

With respect to Item (1) above, the petition was not accompanied by a proper statement under 37 CFR 1.497(d)(1) from Kyeongil Kim requesting that he be added as an inventor.

With the petition, applicant submitted a copy of the signature sheet of the previously submitted declaration. A review of the declaration submitted on 07 March 2005 reveals that the declaration is unacceptable because it identifies the wrong international application number (PCT/RK04/01397), rather than international application PCT/KR04/01397. Applicant must submit a newly executed declaration, in compliance with 37 CFR 1.497(a) and (b), which is directed PCT/KR04/01397.

### CONCLUSION

The petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

The declaration as submitted is not in compliance with 37 CFR 1.497(a) and (b). Applicant must submit a newly executed declaration, in compliance with 37 CFR 1.497(a) and (b), which is directed PCT/KR04/01397.

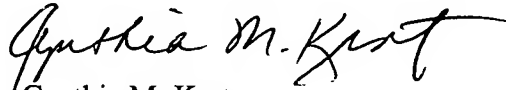
Any reconsideration on the merits of the petition under 37 CFR §1.497(d) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.497(d)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

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<sup>1</sup>37 CFR 1.497(d) states, in part: If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor . . . that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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